

REMARKS

The Office Action of March 11, 2005, has been received and reviewed. Claims 1-24 are pending in the application and all pending claims stand rejected. Claims 1, 2, 9, 11, 21 and 22 have been amended, claims 4 and 12 have been canceled, and new claims 25 and 26 have been added as set forth herein. No new matter has been added. All amendments and cancellations are made without prejudice or disclaimer. Reconsideration is requested.

Rejections under 35 U.S.C. § 103

Claims 1, 9, 11-17, 19 and 21-23

Claims 1, 9, 11-17, 19 and 21-23 stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Chung in view of Bain. Claim 12 has been canceled rendering the rejection thereof moot. Applicant respectfully traverses the rejection as hereinafter set forth.

A *prima facie* case of obviousness cannot be established for any of claims 1, 9, 11-17, 19 and 21-23 since the cited references do not alone, or in combination, teach, suggest or motivate each and every element of any of claims 1, 9, 11-17, 19 and 21-23.

Amended claim 1 is directed towards a method for providing pharmaceutical information to a patient comprising dispensing a pharmaceutical product having an electronically identifiable tag associated with the pharmaceutical product; electronically reading the electronically identifiable tag of the pharmaceutical product to identify the pharmaceutical product; prompting the patient with a selective opportunity to accept or decline prescription counseling by interacting with an electronic input device; wherein the patient selects to accept prescription counseling, retrieving electronically stored pharmaceutical counseling about the pharmaceutical product; and electronically disclosing the stored pharmaceutical counseling to the patient.

Chung does not alone or in combination with Bain teach or suggest each and every element of amended independent claim 1. For instance, Chung does not teach or suggest prompting the patient with a selective opportunity to accept or decline prescription counseling by interacting with an electronic input device, wherein the patient selects to accept the prescription counseling, retrieving electronically stored pharmaceutical counseling about the pharmaceutical product, and electronically disclosing the stored pharmaceutical counseling to the patient as recited in amended claim 1.

Further, Bain does not teach or suggest prompting the patient with a selective opportunity to accept or decline prescription counseling by interacting with an electronic input device, wherein the patient selects to accept the prescription counseling, retrieving electronically stored pharmaceutical counseling about the pharmaceutical product, and electronically disclosing the stored pharmaceutical counseling to the patient as recited in amended claim 1. Bain discloses the use of a patient interface portion that “includes a display screen which conveys information to the patient, such a[s] counseling information.” (Bain, paragraph [0020]). Bain also discloses that a “patient interface portion 8 includes a data interface 24 for entering information, such as the patient’s name, telephone number and a personal identification number.” (*Id.* at paragraph [0040]). However, Bain does not disclose prompting the patient with a selective opportunity to accept or decline prescription counseling by interacting with an electronic input device as recited in amended claim 1.

Since Chung does not alone, or in combination with Bain, teach or suggest each and every element of amended claim 1, it cannot be rendered obvious.

Amended independent claim 11 cannot be rendered obvious since Chung does not alone, or in combination with Bain, teach or suggest each and every element of the claim. For instance, Chung does not teach or suggest a system for providing interactive pharmaceutical information comprising an electronic input device for allowing the patient to accept or decline receiving the stored pharmaceutical counseling, disclosing means for disclosing the stored pharmaceutical counseling to the patient upon interaction of the patient with the electronic input device and means for storing a selection of the patient to accept or decline the stored pharmaceutical counseling as recited in amended claim 11. Chung discloses a system for reading smart tags and does not teach or suggest an electronic input device for allowing the patient to accept or decline pharmaceutical counseling. (*See, Chung*, Abstract).

Bain also does not teach or suggest an electronic input device for allowing the patient to accept or decline receiving the stored pharmaceutical counseling, disclosing means for disclosing the stored pharmaceutical counseling to the patient upon interaction of the patient with the electronic input device and means for storing a selection of the patient to accept or decline the stored pharmaceutical counseling as recited in amended claim 11. Rather, Bain discloses a display screen for displaying information and a patient interface portion that includes a data

interface for entering information, such as the patient's name, telephone number and a personal identification number. (See, Bain at paragraphs [0020] and [0040]). Thus, Bain does not disclose the electronic input device for allowing the patient to accept or decline receiving the stored pharmaceutical counseling and the interactive features of amended claim 11. Thus, Chung and Bain cannot render amended claim 11 obvious.

Chung and Bain also cannot render amended claim 21 obvious since the cited references do not alone, or in combination, teach or suggest each and every element of amended claim 21. For instance, Chung and Bain do not disclose a computer-based apparatus for providing pharmaceutical information to a patient comprising an input device operably configured to provide the patient with a selective opportunity to accept or decline prescription counseling and an output device for disclosing the prescription counseling to the patient upon the patient selecting to accept the prescription counseling as recited in amended claim 21. As previously discussed herein, Chung and Bain do not teach or suggest an input device operably configured to provide the patient with the opportunity to accept or decline pharmaceutical counseling and the interactive elements of amended claim 21.

Since Chung and Bain do not teach or suggest each and every element of amended independent claim 21, it cannot be rendered obvious.

Dependent claims 9, 13-17, 19 and 22-23 depend from one of independent claims 1, 11 and 21 and, thus, include the elements of the base claim. Since Chung and Bain do not teach or suggest each and every element of any of amended, independent claims 1, 11 or 21, Chung and Bain also cannot render obvious any of dependent claims 9, 13-17, 19 and 22-23.

Reconsideration and withdrawal of the obviousness rejections of claims 1, 9, 11, 13-17, 19 and 21-23 are requested.

Claims 2, 4-6 and 10

Claims 2, 4-6 and 10 stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Chung in combination with Bain, and further in view of Catan. Claim 4 has

been canceled rendering the rejections thereof moot. Applicant respectfully traverses the rejection as set forth herein.

Dependent claims 2, 5-6 and 10 depend from and, thus, include the elements of amended, base claim 1. Since a *prima facie* case of obviousness cannot be established for amended, base claim 1 and dependent claims 2, 5-6 and 10 include the elements of amended, base claim 1, a *prima facie* case of obviousness also cannot be established for dependent claims 2, 5-6 and 10.

Reconsideration and withdrawal of the obviousness rejections of claims 2, 5-6 and 10 are requested.

Claims 7, 20 and 24

Claims 7, 20 and 24 stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Chung in combination with Bain, and further in view of Stewart. Applicant respectfully traverses the rejection as hereinafter set forth.

Claims 7, 20 and 24 depend from and, thus, include the elements of one of amended, base claims 1, 11 and 21. Since a *prima facie* case of obviousness cannot be established for amended, base claims 1, 11 and 21, and dependent claims 7, 20 and 24 include the elements of amended, base claim 1, 11 or 21, a *prima facie* case of obviousness also cannot be established for claims 7, 20 and 24.

Reconsideration and withdrawal of the obviousness rejections of claims 7, 20 and 24 are requested.

Claims 3, 8 and 18

Claims 3, 8 and 18 stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Chung in combination with Bain and with Catan, and further in view of Kaafarani. Applicant respectfully traverses the rejection as set forth herein.

Dependent claims 3, 8 and 18 depend from and, thus, include the elements of amended, base claim 1 or 11. Since a *prima facie* case of obviousness cannot be established for amended, base claims 1 and 11, and dependent claims 3, 8 and 18 include the elements of amended, base claim 1 or 11, a *prima facie* case of obviousness also cannot be established for claims 3, 8 and 18.

Reconsideration and withdrawal of the obviousness rejections of claims 3, 8 and 18 are requested.

CONCLUSION

In view of the foregoing amendments and remarks, the applicant respectfully submits that the claims define patentable subject matter and a notice of allowance is requested. Should questions remain after consideration of the foregoing, the Office is kindly requested to contact the applicant's attorney at the address or telephone number given herein.

Respectfully submitted,



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